

### **REMARKS**

This Amendment is submitted in response to the Final Office Action dated May 20, 2003, having a shortened statutory period set to expire August 20, 2003. Claims 15-16, 18-26, and 38 are pending. Claims 15 and 38 have been amended and Claims 1-14, 27-37, 39-43 have been canceled.

#### **Amendments to the Specification**

The specification has been amended to include the serial numbers for the cross references on page 14 and 18. These amendments do not add any new matter to the specification.

#### **Amendments to the Claims**

Claims 15 and 38 have been amended and Claims 1-14, 27-37, 39-43 have been canceled. No new matter has been entered by these amendments. Applicants have canceled claims 1-14, 27-37, 39-40, and 42-43 because they are drawn to a non-elected invention.

#### **Restriction**

In accordance with Applicants election of Claims 15-26, 38, and 41 in the present application, Applicants have herein canceled claims 1-14, 27-37, 39, 40, 42, and 43.

#### **Specification**

The disclosure has been objected to because references to unidentified applications were made on pages 14 and 18. Applicants have amended pages 14 and 18 of the present specification to include the serial numbers for the referenced applications. Applicants believe that this amendment overcomes the objection to the specification.

On page 3 of the present Office Action, the specification has been objected to as failing to provide proper antecedent basis for the claimed subject matter. Although Applicants believe

there is clearly sufficient support in the specification for "storage device carried on the person of said particular user" as recited in Claim 15, particularly on page 16, lines 2-5 and page 19, lines 19-24, Applicants have, nonetheless, chosen to delete the above clause from Claims 15 and 38 in order to overcome the Examiner's objection, since Applicants believe that such a limitation is not necessary for the present invention. Consequently, Applicants believe that this amendment to Claims 15 and 38 should overcome the objection. Accordingly, Applicants respectfully submit that the Examiner should enter this Amendment because it not add new matter, and will clearly reduce issues upon Applicants appeal of the Examiner's rejections in this application (i.e., entering the above amendment resolves the objection to the specification, objections to the drawings, and the rejections of Claims 15, 16, 18-26, and 38 under Section 112, first paragraph).

#### **Drawings**

The drawings have been objected to as not showing every feature of the invention specified in the claims. Applicants have canceled the offending feature from the claims and believe that such amendment overcomes the objection to the drawings.

#### **Terminal Disclaimer**

In section 6 of the present Office Action, the Terminal Disclaimer submitted with Amendment A was objected to because it did not bear the signature of an attorney or agent of record. Applicants submit herewith a Terminal Disclaimer in the present application signed by an attorney of record in this application and disclaiming any terminal period extending beyond the expiration of the co-pending application number 09/560,317. Applicants believe that this Terminal Disclaimer should overcome any actual or provisional double-patenting rejection.

#### **Double Patenting**

In Section 7 of the present Office Action, Claims 15 and 19 of have been provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over at least Claims 11-18 of copending Application No. 09/560,317. Accompanying this response is an appropriately executed Terminal Disclaimer by an attorney of

record in this case, in compliance with 37 CFR § 1.321(c). Applicants believe that this Terminal Disclaimer is sufficient to overcome any actual or provisional rejection based on a non-statutory double patenting ground.

**Claim Rejections – 35 U.S.C. § 112, First Paragraph**

In paragraph 10 of the present Office Action, Claims 15, 16, 18-26, 38 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. That rejection is respectfully traversed and reconsideration of the claims is requested.

As is well known by those skilled in the art, a smart card or ibutton is designed to be carried on the person of a user, and therefore there is clearly support in the specification for the above limitation (see page 16, lines 2-5 and page 19, lines 19-24). Applicant believes that an amendment to the specification to explicitly describe this aspect of a personal storage device such as a smart card would overcome the rejection. However, since Applicants believe that the subject limitation is not necessary for the present invention, Applicants have amended Claims 15 and 38 to remove “carried on the person of said particular user” and believe that this amendment overcomes the rejection under Section 112, first paragraph.

**Claim Rejections – 35 U.S.C. § 102**

On page 7 of the present Office Action, Claims 15-25, 38, and 41 have been rejected under 35 U.S.C. § 102(e) as being anticipated by *Sone* (U.S. Patent No. 6,204,763 B1). This rejection is respectfully traversed and reconsideration of the claims is requested.

Claim 15 recites inter alia:

*receiving food-related inventory preferences for a particular user from among said plurality of users at said controller from a personal electronic memory digital data storage device proffered by said particular user at said controller;*

On page 8 of the present Office Action, it is suggested that *Sone* shows this element of

Claim 15 by the presence of a section of a refrigerated compartment 22 (see column 6, lines 16-23 of *Sone*).

Applicants respectfully disagree that a refrigerator compartment can in any way show or suggest a personal electronic memory digital data storage device. Specifically, second section 22B of refrigerated compartment 22 cannot be interpreted as "*a personal electronic memory digital data storage device*," as is recited in Claim 15, nor can it be suggested that refrigerator compartment 22B stores "*food-related inventory preferences*" such that they can be received from the refrigerator at a data processing controller (i.e., "*proffered by said particular user at said controller*"), as is recited in Claim 15.

Applicants note that the Examiner's interpretation that a "*personal electronic memory digital data storage device*" is equivalent to a refrigerated compartment is not tenable, even giving the claims their broadest reasonable interpretation. During patent examination, the pending claims should be "given the broadest reasonable interpretation consistent with the specification." *In re Prater*, 451 F.2d 1393, 1404-05, 162 USPQ 542, 550-51 (CCPA 1969) (emphasis by Applicants). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach (see, *In Re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (Also see MPEP § 2111). "Claims are not to be read in a vacuum, the limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation.'" *In re Marosi*, 710 F.2d 799, 218 USPQ 2nd 289 (Fed. Cir. 1983) (quoting *In re Ocuzawa*, 537 F.2d 545, 548, 190 USPQ 2nd 464, 466 (CCPA 1976)) (emphasis in original). Where not defined by Applicant in the specification, the words of a claim must be given their plain meaning as they would be interpreted by those of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 218 USPQ 2nd 385 (Fed. Cir. 1983) (also see MPEP § 2111.02).

Therefore, as evidence of how someone of ordinary skill in the art of computers and electronics (as opposed to appliances) would interpret Claim 15, Applicants present the following definitions:

**personal** 1: of, relating to, or affecting a person: PRIVATE INDIVIDUAL . . . 3: relating to the person or body." Merriam-Webster's Collegiate Dictionary, 10<sup>th</sup> Edition, Merriam-Webster Inc., Springfield, MA, 1995.

**electronic** 1: of or relating to electrons 2: of, relating to, or utilizing devices constructed or working by the methods or principles of electronics; *also* : implemented on or by means of a computer .... Merriam-Webster's Collegiate Dictionary, *supra*.

**memory** Circuitry that allows information to be stored and retrieved.... Computer Dictionary, 2<sup>nd</sup> Edition, Microsoft Press, Redmond, WA, 1993.

**digital** Related to digits or the way they are represented. In computing, *digital* is virtually synonymous with *binary* because the computers familiar to most people process information coded as combinations of binary digits (bits). ... Computer Dictionary, *supra*.

**data** Plural of the Latin *datum*, meaning an item of information.... Computer Dictionary, *supra*.

**storage** In computing terms, any physical device in or on which computer information can be kept.... Computer Dictionary, *supra*.

**device** "A generic term for a computer subsystem. Printers, serial ports, and disk drives are often referred to as devices; such subsystems frequently require their own controlling software called device drivers." Computer Dictionary, *supra*.

**storage device** Any apparatus for recording computer data in permanent or semipermanent form.... Computer Dictionary, *supra*.

**proffer** : to present for acceptance : TENDER, OFFER. Merriam-Webster's Collegiate Dictionary, *supra*.

Given each of the terms within Claim 15 their ordinary meaning, as evidenced by the above definitions, someone of ordinary skill in the art would in no way read a refrigerator compartment as being equivalent to the storage device recited in Claim 15. To exemplify Applicant's point, the above definitions tied together to specifically point out and distinctly claim a "*personal electronic memory digital data storage device*" would be "relating to the person or body, utilizing devices constructed or working by the methods or principles of electronics or implemented on or by means of a computer, having circuitry that allows information to be stored and retrieved, related to digits or the way they are represented, and process information coded as combinations of binary digits (bits), an item of information, apparatus for recording computer data in permanent or semipermanent form." This is not a refrigerator compartment.

Notwithstanding the misapplication of *Sone's* refrigerator to the claimed limitations in the present application, nothing within *Sone* suggests that such a refrigerator contains "*food-related inventory preferences for a particular user from among said plurality of users*" and that such a refrigerator can transfer those preferences such that they are received "*at said controller*"

from the refrigerator, as recited in Claim 15. Moreover, nothing within the cited section of *Sone* suggests that the refrigerator is "*proffered by said particular user at said controller,*" as is recited in Claim 15. It is not a reasonable to suggest that *Sone* suggests that a user would present a refrigerator for acceptance by a controller (see definition of "proffer").

Consequently, Applicants respectfully submit that *Sone* does not anticipate the present invention as claimed in Claim 15 and the rejection under Section 102 should be withdrawn. Claim 38 and dependent claims 16-26 are drawn to similar subject matter. For the reasons given above with respect to Claim 15, Applicants submit that *Sone* does not anticipate Claims 16-26 and 28 for the reasons given above and the rejection of those claims under Section 102 should be withdrawn.

#### Claim Rejections – 35 U.S.C. § 103

In Section 18 of the present Office Action, Claims 15-25, 38, and 41 have been alternatively rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sone*. That rejection is respectfully traversed and reconsideration of the claims is requested.

With respect to Claim 15, Applicants respectfully submit that for the reasons given above explaining that *Sone* does not anticipate the present invention as claimed in Claims 15-25, 38, and 41, Applicants submit that the present invention is patentable over *Sone* and that the rejection under Section 103 should be withdrawn. With respect to Claim 15, nothing within *Sone* suggests that there would be any utility, capability or possibility for allowing a user to input their preferences using a SmartCard-type memory device within the replenishment system of *Sone*. There is no teaching in the reference that would render such a modification to the system obvious to someone skilled in the art at the time the invention was made. The Examiner's suggestion that there is nonetheless utility and motivation (i.e., monetary gain and a better inventory system) is not a convincing line of reasoning on how someone of ordinary skill in the art would somehow see the present invention as obvious or would modify *Sone* to arrive at the present invention. ("To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or implicitly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found

the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 277 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)). Applicants respectfully submit that the Examiner has used improper hindsight in light of the present application to find the present invention obvious. Consequently, Applicants respectfully submit that the pending claims of the present application are not obvious in light of *Sone* and that the rejection under Section 103 should be withdrawn.

In section 19 of the present Office Action, Claim 26 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sone* in view of *Salvo et al.* (US Patent No. 6,341,271). That rejection is respectfully traversed and reconsideration of the claim is requested. For the reasons given above with respect to the patentability of Claim 15, Applicants submit that Claim 26 is similarly not shown or suggested by *Sone* in view of *Salvo* and submit that the rejection under Section 103 should be withdrawn.

**Applicants Rebuttal to Examiner's Response to Applicants Remarks in Amendment A:**

With respect Sections 22 and 23 of the present Office Action, the recited sentence of Applicants' remarks was meant to summarize Applicants' argument for purposes of clarity and argument. Applicants' specific legal argument was presented in the next sentence, where particular claim language was recited and compared against the Examiner's rejection to demonstrate the lack of inherency or obviousness presented by the prior art reference. The Examiner has responded to the first sentence but not the second. Through this obfuscation, the Examiner has successfully avoided presenting any defense for the rejection of the claims as being anticipated by *Sone* in the face of Applicants's arguments with the Examiner's application of *Sone* to the claims. Applicants respectfully request a considered response to the arguments presented herein that the refrigerator compartment described in *Sone* cannot in any way show or suggest a personal electronic memory digital data storage device for storing user preferences. With respect to Section 23 of the present Office Action, Applicants respectfully note page 16, lines 2-5 of the present specification.

Applicants' suggestion that nothing within *Sone* suggests any utility that would arise

from the present invention was intended to evidence the lack of any motivation, let alone any teaching, to modify *Sone* as suggested by the Examiner. As stated in MPEP § 2142-2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

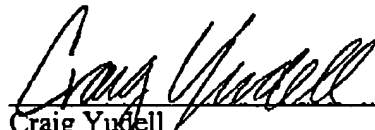
As has been argued in Applicants remarks to the Section 103 rejection, *Sone* makes no suggestion to one of ordinary skill in the art to make the modifications as suggested by the Examiner to the refrigerator compartment to arrive at the present invention of a personal memory device (e.g., a SmartCard, see the specification, page 16, lines 2-5) to arrive at the present invention. The mere fact that references can be combined or modified does not render the result and combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d. 680, 16 USPQ2d 430 (Fed. Cir. 1990). Moreover, the Examiner has failed to present a convincing line of reasoning on why it would nonetheless be obvious to modify *Sone's* refrigerator compartment to store user preferences like a SmartCard-type device does.



**Conclusion**

In summary, Applicants respectfully submit that the claims in the present application are not obvious in view of *Sone* and request reconsideration of the rejection under Section 103. There being no other grounds for rejection, Applicants believe the present application is now in condition for allowance.

Respectfully submitted,



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Doc ID 120391